

In re Appln. of Clark et al.
Application No. 09/873,546

The Office further asserts that group (v) is generic to a plurality of patentably distinct inventions set forth in groups (iv) and (v), and, consequently, if either of groups (iv) or (v) is elected, the claims of the group will be examined only to the extent that they are defined by the elected group.

Election with Traverse

Applicants hereby elect the claims of group (i) with traverse.

Discussion of Restriction Requirement

There are two criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, and (ii) there must be a serious burden on the examiner if restriction is not required. M.P.E.P. § 803. Consequently, as set forth in M.P.E.P. § 803, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." Applicants submit that the restriction is improper in view of the above and traverse the restriction for the reasons set forth below.

The Office alleges that the claims of group (v), namely claims 21, 22, and 24-27, are drawn to methods of inhibiting cell growth *in vitro*. Applicants submit that these claims are not so limited. Therefore, Applicants submit that there is no undue burden for the Examiner to examine these claims together with the claims of group (iv), which further encompass claims 23 and 28, in addition to claims 21, 22 and 24-27.

The Office further alleges that claims 1-4 and 6-16 should be separately searched and examined from the claims of groups (iv) and (v). Applicants submit that claims 21-28 are directed to the use of the recombinant expression vector of claim 1 and are dependent thereon. In this respect, art that would be uncovered as relevant to the examination of the claims of group (i) would likely be covered by the Office in the examination of the claims of groups (iv) and (v) and *vice versa*. This is not to say that the claims stand or fall together but, rather, that it would not be unduly burdensome for the Office to examine the claims of groups (i), (iv), and (v) together.

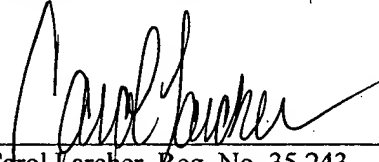
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In view of the foregoing, Applicants request the withdrawal of the restriction requirement in whole or in part. At the very least, Applicants request that groups (iv) and (v) be examined with group (i).

Respectfully submitted,



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Date: February 24, 2003

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CERTIFICATE OF MAILING

I hereby certify that this RESPONSE TO RESTRICTION REQUIREMENT (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Date: February 24, 2003

Kedron H. Grant

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